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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79143993
Applicant	SANA Hotels and Resorts Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re:)
)
Serial No. 79143993)
)
Applicant: SANA Hotels and Resorts Limited)
)
Filed: January 15, 2014)
)
Mark: EPIC SANA LUXURY CONCEPT HOTELS)
)

APPLICANT’S APPEAL BRIEF

Applicant, SANA Hotels and Resorts Limited, hereby appeals to the Trademark Trial and Appeal Board from the Examining Attorney’s Final refusal of registration dated November 24, 2014.

FACTS OF THE CASE

On January 15, 2014, applicant applied for the mark below in connection with, among other services “providing temporary accommodation,” in class 043.



On April 17, 2014, the Examining Attorney issued an office action based on a likelihood of confusion with registration nos. 3453879 (EPIC and design) and 3698111 (EPIC) in connection with “hotel services.” The Examining Attorney also refused registration of applicant’s mark based on registration no. 3583748 in connection with “full service hotel, hotels, resort hotels, resort lodging services,” in class 043. The mark for registration no. 3583748 is depicted below.



On October 17, 2014, applicant filed a response. As part of that response, applicant argued that applicant’s mark would not be confused with registration no. 3583748 because both applicant’s and registrant’s marks are composite marks whose design features, stylization, and additional words are sufficiently different to avoid confusion.

On November 24, 2014, the Examining Attorney issued a Final Refusal, withdrawing the likelihood of confusion refusal based on registration nos. 3453879 (EPIC and design) and 3698111 (EPIC), but maintaining the likelihood of confusion refusal with regard to registration no. 3583748. The Examining Attorney argued that the word SANA is the dominant feature of the marks, because the additional wording in both marks have all been disclaimed, and the word portion of a mark creates a more dominant commercial impression than the design feature.

ISSUE TO BE DECIDED

1. Whether Applicant's mark, "EPIC SANA LUXURY CONCEPT HOTELS (and design)," in connection with " providing temporary accommodation," in class 043, is likely to be confused with Registrant's mark, "SANA RESORT AND HOTEL (and design)" in connection with "full service hotel, hotels, resort hotels, resort lodging services," in class 43 under Trademark Act Section 2(d).

ARGUMENTS

A. Applicant's mark must be view in its Entirety

Although the Applicant's Mark and Registrant's Mark recite accommodation services in class 43 and contain the word SANA, Applicant respectfully submits that there is no likelihood of confusion. Among the factors to consider in a likelihood of confusion analysis, the principal factors relevant to this case are the similarities in appearance, sound, connotation and commercial impression of the marks. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In such an analysis, the Examining Attorney must consider the trademarks in their entirety to determine whether or not there may be a likelihood of confusion. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 USPQ2d 1442, 1445 (8th Cir. 1987). Further, a likelihood of confusion may not be predicated on only part of a mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992) (stating that marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight).

When comparing conflicting marks, a mark should not be dissected into its component parts and each part then compared with corresponding parts of the conflicting mark to determine a likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538 (U.S. 1920). As the Supreme Court noted, “[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value.” *Id.* at 546-547.

Moreover, while it is often true that the word portion of a mark is more likely to be impressed upon a purchaser’s memory, that is not the case in every situation. *See In re Electrolyte Laboratories*, 16 U.S.P.Q.2d 1239 (CCPA 1990) (stating that there is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue). Nevertheless, no element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. *Id.*; *See also Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 U.S.P.Q. (CCPA 1974).

Here, applicant’s mark contains the additional wording “EPIC,” which precedes the common wording “SANA,” the slogan “LUXURY CONCEPT HOTELS,” and a distinctive flower design feature. Moreover, the application claims color as a feature of the mark, namely, brown and white. By contrast, the cited mark contains the word “SANA” with no preceding words, followed by different wording, “RESORT & HOTEL,” a distinctive crown design, and a different color claim, namely, light gold and black.

When viewed in its entirety, prospective consumers would not likely believe that applicant’s mark is associated with registrant’s mark due to the overall differences in both marks.

Moreover, the first word in applicant’s mark, EPIC, is different. As a general rule, consumers are more inclined to focus on the first word, prefix or syllable in any trademark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En*

1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)(“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

CONCLUSION

When viewed in its entirety, applicant’s mark is not likely to be confused with registrant’s mark. This is especially so because of the different additional wording, different design features, and different color claims.

WHEREFORE, Applicant prays that the Examining Attorney’s refusal of registration be reversed and that registration be granted.

Submitted: April 8, 2015

By: _____/John Alumit/_____

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